

1 UNITED STATES DISTRICT COURT
2 WESTERN DISTRICT OF NEW YORK
3
4
5
6

7 - - - - - X
8 BAUSCH & LOMB, INC., et al.,
9 Plaintiffs
10 vs.

13-CV-6498(JWF)

11 VITAMIN HEALTH, INC.
12 Defendant
13 - - - - - X

Rochester, New York
July 29, 2016
8:30 a.m.

14
15 TRANSCRIPT OF PROCEEDINGS
16 BEFORE THE HONORABLE JONATHAN W. FELDMAN
17 UNITED STATES MAGISTRATE JUDGE
18
19
20
21
22

23 COURT REPORTER: Christi A. Macri, FAPR-CRR
24 Kenneth B. Keating Federal Building
25 100 State Street, Room 2120
Rochester, New York 14614

A P P E A R A N C E S

HARTER, SECREST AND EMERY, LLP

BY: ERIKA N.D. STANAT, ESQ.

1600 Bausch & Lomb Place

Rochester, New York 14604

- and -

FITZPATRICK, CELLA, HARPER & SCINTO

BY: DAMIEN N. DOMBROWSKI, ESQ.

STEVEN C. KLINE, ESQ.

1290 Avenue of the Americas

New York, New York 10104-3800

Appearing on behalf of the Plaintiffs

CARLSON GASKEY & OLDS, P.C.

BY: STEVEN C. SUSSER, ESQ.

BRIAN S. TOBIN, ESQ.

MICHAEL A. SZYPA, ESQ.

400 West Maple Road, Suite 350

Birmingham, Michigan 48009

Appearing on behalf of the Defendant

P R O C E E D I N G S

* * *

THE CLERK: Judge Feldman presiding. Please be seated. This is Bausch & Lomb vs. Vitamin Health, 13-CV-6498. July 29, 2016.

MAGISTRATE JUDGE FELDMAN: Good morning. We've got a lot to do here and not a lot of time to do it in so I want to just go over what I want to accomplish.

I want to talk about rulings on depositions; I want to have some oral argument on the motion to dismiss; we need to address the designations of excerpts of deposition testimonies on the Doctrine of Equivalents -- Mr. Meyering, Mr. Balaram and Mr. Ferris; I want to talk about the validity summary judgment motion filed by Bausch & Lomb; and Vitamin Health's summary judgment motion on the issue of prosecution estoppel; I want to talk about what questions will be presented to the jury on enablement; I want to talk a little bit about the schedule next week; and any changes to the witness list.

So unless somebody has a particular item they want to address first, I thought I would just go in order here.

MR. SUSSER: That's fine, Your Honor.

MAGISTRATE JUDGE FELDMAN: Okay. Starting with the ruling on the depositions, I'm almost through them and I will give you my rulings, at least preliminarily, Monday morning

1 before we start with jury selection.

2 I assume most of these depositions are video
3 depositions?

4 **MR. DOMBROWSKI:** I think roughly half and half. I
08:38:01AM 5 don't think there's --

6 **MAGISTRATE JUDGE FELDMAN:** Well, I know you would
7 have to make on the video depositions edits depending on my
8 rulings. So I don't know how much time you need to do that,
9 but you might want to consider the order that you play the
08:38:13AM 10 depositions, the video depositions, if you need time to do
11 that.

12 **MR. KLINE:** Well, I think if we have the ruling by
13 Monday, I know none are going on on Monday so --

14 **MAGISTRATE JUDGE FELDMAN:** Okay, fine. Then let's
08:38:28AM 15 get to some argument on the motion to dismiss, which I know
16 the timing of this is kind of problematic, but I think we've
17 got to get it resolved.

18 So who should I ask questions to from Bausch & Lomb
19 here?

08:38:44AM 20 **MR. DOMBROWSKI:** I can answer questions on that.

21 **MAGISTRATE JUDGE FELDMAN:** Okay. You sued Vitamin
22 Health for products which you allege have infringed or are
23 currently infringing on both your '297 and your '522 patents,
24 right?

08:39:02AM 25 **MR. DOMBROWSKI:** Correct.

1 **MAGISTRATE JUDGE FELDMAN:** Okay. Are you aware of
2 any current Vitamin Health product that infringes on the '522
3 patent that you're not including in your complaint?

4 **MR. KLINE:** We're not aware of any.

08:39:14AM 5 **MAGISTRATE JUDGE FELDMAN:** Okay. I mean, clearly if
6 they were marketing something and making money off of it, you
7 would be concerned about it if it violated your patent?

8 **MR. DOMBROWSKI:** I think that's right.

9 **MAGISTRATE JUDGE FELDMAN:** Okay. Now, we're
08:39:28AM 10 scheduled to commence the trial on Monday. I think your
11 motion was filed on Wednesday, but yesterday I sent you this
12 *Hillman* case because I was interested in the case or
13 controversy discussion in there.

14 I was well aware that it was a case involving a
08:39:44AM 15 defendant who had filed a declaratory judgment action on
16 patent validity, but it was the case or controversy discussion
17 related to that invalidity claim that was of interest to me.

18 Now, in that case the plaintiff offered to dismiss
19 the infringement claim with prejudice, which included a
08:40:04AM 20 covenant not to sue for any infringing acts for past or
21 current products.

22 And the defendant there argued that the declaratory
23 judgment action on validity would survive that because they
24 wanted a promise not to sue for any future products.

08:40:24AM 25 Is that your reading of the case?

1 **MR. DOMBROWSKI:** It is.

2 **MAGISTRATE JUDGE FELDMAN:** Okay. Now here you're
3 moving to dismiss the '522 patent with prejudice. Is it
4 inherent on a dismissal with prejudice under the facts here
08:40:40AM 5 that you're not going to be suing on any past or current
6 products?

7 **MR. DOMBROWSKI:** I think that's correct. I think
8 the claim preclusion rules, you know, in a later action it
9 would be limited to the products that were essentially the
08:40:52AM 10 same as the products in the --

11 **MAGISTRATE JUDGE FELDMAN:** Okay. And all the
12 products that you are aware of that are infringing on the '522
13 patent are within the purview of this motion to dismiss with
14 prejudice?

08:41:03AM 15 **MR. DOMBROWSKI:** Current, the current accused
16 products, correct.

17 **MAGISTRATE JUDGE FELDMAN:** You're not aware of any
18 products that infringe or allegedly infringe that you haven't
19 sued on?

08:41:11AM 20 **MR. DOMBROWSKI:** That's my understanding, yeah.

21 **MAGISTRATE JUDGE FELDMAN:** Okay. And it's the same
22 analysis with respect to the false advertising claims, the
23 action would be dismissed with prejudice as to the products
24 covered by the complaint, correct?

08:41:24AM 25 **MR. DOMBROWSKI:** Correct.

1 **MAGISTRATE JUDGE FELDMAN:** Okay. Who do I ask
2 questions to here?

3 **MR. TOBIN:** Me, Your Honor.

4 **MAGISTRATE JUDGE FELDMAN:** Like the defendant
08:41:40AM 5 seeking the declaratory judgment in *Hillman*, you agree that
6 dismissal with prejudice is essentially a covenant not to sue
7 you for any past or current products that may infringe on
8 your -- on the '522 patent?

9 **MR. TOBIN:** Your Honor, I believe that with *Hillman*,
08:41:58AM 10 there was both the dismissal with prejudice as well as the
11 covenant not to sue.

12 **MAGISTRATE JUDGE FELDMAN:** I understand that, but as
13 a practical matter, wouldn't a dismissal with prejudice give
14 you the same benefit as a covenant not to sue when you have a
08:42:13AM 15 representation here that unless there's some product you're
16 hiding from them that you haven't marketed, that it covers all
17 the products?

18 **MR. TOBIN:** Well --

19 **MAGISTRATE JUDGE FELDMAN:** Past or current products?

08:42:28AM 20 **MR. TOBIN:** -- I think there's a question as to what
21 past or current or future products they're referring to.

22 **MAGISTRATE JUDGE FELDMAN:** What is the question?
23 What product do you have that is not within the scope of this
24 lawsuit?

08:42:46AM 25 **MR. TOBIN:** I believe there's at least one product

1 that -- and I don't know if it's within the scope of this
2 lawsuit. You know, the four corners of the complaint were
3 pretty broad, the contentions were different.

4 But if you look at the four corners of the
08:42:58AM 5 complaint, I think they're accusing all of our AREDS and AREDS
6 2 products of infringing, but there are certain products of
7 ours which they haven't pursued further.

8 **MAGISTRATE JUDGE FELDMAN:** Okay. In your memo you
9 stated you -- even with the dismissal with prejudice, you're
08:43:14AM 10 open to suit on current products that are not included in the
11 '522 complaint.

12 What is that product you're referring to?

13 **MR. TOBIN:** Any product that wouldn't be in the
14 complaint. I mean --

08:43:25AM 15 **MAGISTRATE JUDGE FELDMAN:** You know your products.
16 What product are you worried about?

17 **MR. TOBIN:** Well, I think the question is we're
18 worried about the current as well as the future products here,
19 Your Honor.

08:43:33AM 20 **MAGISTRATE JUDGE FELDMAN:** Take future out of it,
21 we'll get to future.

22 But current or past product -- past product doesn't
23 really matter, but current product, what current product are
24 you worried about?

08:43:43AM 25 **MR. TOBIN:** I think as it relates to the current

1 products, Your Honor, the one product that I can think of
2 offhand here today they have not pursued anything on would be
3 the Viteyes Complete product as an example.

4 **MR. KLINE:** I'm not certain what the formulation of
08:43:56AM 5 the Viteyes Complete product is. I mean, we've tried to
6 identify all the ones that had the amounts of the
7 ingredients --

8 **MAGISTRATE JUDGE FELDMAN:** Is this being sold on
9 your website? Is this -- what is the composition of the
08:44:07AM 10 Viteyes?

11 **MR. TOBIN:** It's just a variation of our other
12 formulas. It is available on the company's website, or at
13 least it was. I don't know if it still is being sold, but it
14 certainly was.

08:44:19AM 15 **MR. KLINE:** Well, I mean, if he can tell me what the
16 amounts of the ingredients are, I mean, if it was probably
17 being sold when this lawsuit began and we were aware of it,
18 I'm assuming it was outside the patent, but --

19 **MAGISTRATE JUDGE FELDMAN:** Okay. You take this
08:44:37AM 20 patent very seriously. I have to believe that if there was
21 something out there that was conceivably within the patent,
22 you would be suing on it.

23 You also mention in your memorandum of law that you
24 were worried about modifications to current products. What's
08:45:01AM 25 the difference between a future product and a modification to

1 a current product?

2 **MR. TOBIN:** I think in some instances they would
3 fall in the same category. It would -- it could be a future
4 product if there's a modification made.

08:45:13AM 5 For example, if one of the components was changed
6 or the concentration of one of the components was changed.

7 **MAGISTRATE JUDGE FELDMAN:** That would be a future
8 product if you changed it? Okay, they're the same thing.

9 So the point of *Hillman* was that even though the
08:45:25AM 10 defendant claimed there was a case or controversy over future
11 products, the Court disagreed and said that a case or
12 controversy sufficient to maintain jurisdiction can't be based
13 on a fear of litigation over future products.

14 If the dismissal here immunizes you from suit for
08:45:44AM 15 infringement over past or current products that could possibly
16 infringe on the '522 patent, isn't all you're left with then a
17 fear of litigation of a product that has yet to come to
18 market, and under the holding of *Hillman*, is that not enough
19 for a case or controversy?

08:46:07AM 20 **MR. TOBIN:** Well, I think, number one, it's the
21 products that are -- that could have been covered by the
22 complaint. So there's also the issue with that
23 Viteyes Complete product.

24 But I would note, Your Honor, I think the proposal
08:46:17AM 25 by Bausch indicates that they want it not just dismissed with

1 period. They want it dismissed with prejudice with several
2 qualifiers, one of which being that it is limited in some way
3 to Vitamin Health; another way that it's limited to the
4 certain products.

08:46:36AM 5 And I think that there's a difference between
6 dismissing the case with prejudice period and dismissing the
7 case with prejudice with additional caveats.

8 **MAGISTRATE JUDGE FELDMAN:** I understand. Which is
9 why I've been exploring your concern about additional caveats.
08:46:52AM 10 There isn't a single product that I know of that you've
11 mentioned to me that you've created a record that you have any
12 reason to be concerned about. You know your products.

13 **MR. TOBIN:** I think, Your Honor, I mean, this could
14 be something to dispute another day and there could be other
08:47:07AM 15 issues that come up as a result of this.

16 I think that if they're looking to have this case
17 dismissed with prejudice, and if this case is going to be
18 dismissed with prejudice, especially when we've gone
19 through -- I mean, and we've spent a long time on this, we
08:47:19AM 20 don't want to face it again.

21 You know, defendant just asked for a *Markman* ruling
22 three weeks ago on an issue and thereby rendered the claim
23 invalid.

24 **MAGISTRATE JUDGE FELDMAN:** I feel for you, okay? I
08:47:32AM 25 do. But I've got to look at the law on this.

1 And when you look at prejudice, I think the law is
2 if you're put in the same spot you would be put in had you
3 prevailed, okay? You have no legal prejudice. Those are the
4 cases that I've read.

08:47:56AM 5 In other words, it's like you'd gone to trial and
6 prevailed on this. You get the same benefits you would have
7 gotten if the jury verdict came in your favor on the '522
8 patent.

9 **MR. TOBIN:** Your Honor, I think what you're saying
08:48:07AM 10 is definitely -- I understand where you're coming from.
11 I'll say this: If the case is dismissed with prejudice
12 period, in some ways that would be similar to a jury rendering
13 a verdict.

14 If the claim is dismissed with prejudice with
08:48:24AM 15 qualifiers of any sort, that is not consistent with how the
16 jury would be ruling.

17 **MAGISTRATE JUDGE FELDMAN:** I don't know of any
18 qualifiers on a dismissal with prejudice.

19 Now, whatever preclusive effect you would have
08:48:39AM 20 gained by going to trial and winning, you get the same
21 preclusive effect.

22 **MR. TOBIN:** Understood, Your Honor. Are you asking
23 that if there's an issue, if it's just dismissed with
24 prejudice period?

08:48:50AM 25 **MAGISTRATE JUDGE FELDMAN:** Correct. I already said

1 I'm not going to dismiss it without prejudice.

2 **MR. TOBIN:** But if it's dismissed with prejudice,
3 there wouldn't be other qualifiers that went along with it?

4 **MAGISTRATE JUDGE FELDMAN:** No. It would be a
08:49:01AM 5 dismissal with prejudice.

6 **MR. TOBIN:** Okay. Your Honor, the only thing that I
7 would say that comes out of that is the additional
8 considerations that could effect Vitamin Health would be, for
9 example, as relates to these same products which are at issue
08:49:13AM 10 in this litigation and covered by the complaint in this case,
11 there could be the possibility of, for example, Vitamin
12 Health's manufacturer being sued.

13 As this Court is well aware, that's a sensitive
14 issue in this case.

08:49:25AM 15 **MAGISTRATE JUDGE FELDMAN:** It is. But even the case
16 you cited to me, the *Dow Jones* case, you know, there was a
17 issue there about their successors or their customers, and it
18 said it didn't prevent the lack of subject matter
19 jurisdiction.

08:49:42AM 20 I understand you're trying to protect them, but I
21 don't think they would be protected if you won.

22 **MR. TOBIN:** Well, I think, Your Honor, the Court
23 pointed us to the *Hillman* case, and the *Hillman* case -- I
24 mean, those additional protections were provided, at least in
08:49:57AM 25 part, through that covenant not to sue. And that was part of

1 the resolution of the case and controversy.

2 **MAGISTRATE JUDGE FELDMAN:** I understand that. But I
3 don't have those customers in front of me. They're not part
4 of this lawsuit.

08:50:09AM 5 I don't think there's anything I can do or anything
6 you would have been able to do in this lawsuit to bring them
7 in.

8 **MR. TOBIN:** I don't know that in the *Hillman* matter,
9 though, Your Honor, that the customers were part of that
08:50:19AM 10 lawsuit either.

11 **MAGISTRATE JUDGE FELDMAN:** I understand, I
12 understand.

13 **MR. DOMBROWSKI:** Your Honor, can I make one point
14 just to address his point about the qualifiers? I think we
08:50:28AM 15 could make more clear in our motion, but the dismissal with
16 prejudice has the effect of what we're saying it would have an
17 effect of -- be limited to Vitamin Health and to the specific
18 accused products in this case.

19 So we weren't asking for additional limitations to
08:50:41AM 20 be imposed on it. That is the effect of the dismissal with
21 prejudice on our --

22 **MAGISTRATE JUDGE FELDMAN:** Exactly. I'm not putting
23 any qualifiers on a dismissal with prejudice. Because if I
24 do, then it's not really truly a dismissal with prejudice and
08:50:51AM 25 the analysis is far different.

1 I think if it was a dismissal without prejudice,
2 given the status of this case and the posture in which you're
3 making the motion, it would be a lot tougher. In fact, I
4 think I would rule in Vitamin Health's favor.

08:51:05AM 5 Okay, anything else on this issue?

6 **MR. TOBIN:** The only other issue we would note, Your
7 Honor, I don't know if it's an issue for now or for down the
8 road, but to the extent that this matter was dismissed as it
9 relates to the motion to dismiss, we would want the fees that
08:51:20AM 10 we've incurred as it relates to --

11 **MAGISTRATE JUDGE FELDMAN:** Okay, I'll get to that in
12 a minute.

13 **MR. TOBIN:** Sure.

14 **MAGISTRATE JUDGE FELDMAN:** All right. I'm ready to
08:51:26AM 15 rule on this and I'm going to read my decision into the
16 record.

17 A jury trial in this matter is scheduled to
18 commence on Monday, August 1st, 2016.

19 On Wednesday, July 26th Bausch & Lomb filed an
08:51:38AM 20 unanticipated motion for dismissal of Counts 2 and 3 of the
21 second amended complaint.

22 Their motion requested in the first instance
23 dismissal without prejudice; or in the alternative, dismissal
24 with prejudice.

08:51:53AM 25 I ordered expedited briefing, which was completed

1 yesterday. Yesterday I also notified counsel that I was not
2 inclined to dismiss these claims without prejudice.

3 This morning we completed a hearing on this motion.
4 Based on the law and the arguments of counsel, I am granting
08:52:11AM 5 Bausch & Lomb's motion to dismiss Counts 2 and 3 with
6 prejudice.

7 Ordinarily I would issue a written decision, but
8 because this is Friday and jury selection starts Monday
9 morning, I am compelled to write -- or excuse me, I am
08:52:25AM 10 compelled to issue an oral decision which I will now read into
11 the record.

12 A voluntary dismissal with prejudice is generally
13 considered to be an adjudication on the merits with full
14 preclusive effect. I'm citing *Bioxy, Inc. vs. Birko,*
08:52:45AM 15 *Corporation*, 935 F.Supp. 737, at page 741, which is an Eastern
16 District of North Carolina case from 1996.

17 Indeed, "it is generally considered an abuse of
18 discretion for a court to deny a plaintiff's request for
19 voluntary dismissal with prejudice."

08:53:08AM 20 I'm citing *Degussa Admixtures, Inc. vs. Burnett*,
21 471 F.Supp.2d 848, at page 852, a Western District of Michigan
22 case decided in 2007, which relied on a case called *Smoot vs.*
23 *Fox*, 340 F.2d 301, at page 303, a Sixth Circuit case decided
24 in 1964.

08:53:41AM 25 Where a plaintiff's Rule 41(a)(2) motion

1 "specifically requests dismissal with prejudice, it has been
2 held that the District Court must grant that request, relying
3 on Professors Wright and Miller's treatise Federal Practice
4 and Procedure, Section 2367, third edition published in 2008.

08:54:07AM 5 That quote was used in *United States, ex rel McLain*
6 *vs. Fluor Enterprises, Inc.*, which was an Eastern District of
7 Louisiana case decided March 15th, 2016, and is found at
8 2016 WL 1031324.

9 The granting of plaintiff's voluntary motion to
08:54:35AM 10 dismiss with prejudice essentially puts the defendant in the
11 same position as if they had gone to trial and prevailed on
12 the counts subject to dismissal.

13 The rights and remedies garnered by the defendant
14 as a result of the dismissal with prejudice are equal to those
08:54:52AM 15 obtained had there been a finding in their favor, which is why
16 there is no legal prejudice from this type of dismissal.

17 "No matter when a dismissal with prejudice is
18 granted, it does not harm the defendant. The defendant
19 receives all that he would have received had the case been
08:55:11AM 20 completed." That quote is from *Schwarz vs. Folloder*, 767 F.2d
21 125, at page 129, a Fifth Circuit case decided in 1985.

22 Vitamin Health opposed dismissal of the two counts
23 even with prejudice. They have not cited to the Court any
24 cases where a court has refused to grant a dismissal with
08:55:40AM 25 prejudice, but argue that a dismissal is unfair and improper

1 without an open-ended and unrestricted promise from
2 Bausch & Lomb that Bausch & Lomb will not sue Vitamin Health
3 for not only past and current products, but also future
4 products.

08:55:55AM 5 Again, Vitamin Health has not pointed to any case,
6 patent or otherwise, in which a patent holder was required to
7 covenant not to sue for possible infringement on any future
8 product the competitor might market during the life of the
9 patent. I could not find any such case either.

08:56:12AM 10 Indeed, the only patent case the Court found
11 relevant to this issue was *Hillman Group vs. Minute Key*, found
12 at 2014 WL 4064187, a Southern District of Ohio case decided
13 August 15th, 2014.

14 Although the facts in *Hillman* involved a patent
08:56:30AM 15 infringement action by a plaintiff in a declaratory judgment
16 action as to patent validity by the defendant, the issue of
17 case or controversy arose when the plaintiff withdrew its
18 infringement action and promised not to sue the defendant for
19 current or past products alleged to have been infringing on
08:56:47AM 20 the patent.

21 The defendant still wanted the Court to maintain
22 jurisdiction over the declaratory judgment action, but the
23 Court found there was no longer a case or controversy.

24 The Court explained as follows, and I'm quoting,
08:57:01AM 25 "as the Supreme Court has noted, plaintiff may not like --

1 excuse me, plaintiff may not obtain a declaratory judgment
2 merely because it would like an advisory opinion on whether it
3 would be liable for patent infringement if it were to initiate
4 some merely contemplated activity.

08:57:18AM 5 Plaintiff must be engaged in the actual making,
6 selling or using activity subject to an infringement charge or
7 must have made meaningful preparation for such activity. An
8 actual controversy cannot be based on a fear of litigation
9 over future products." That's from page 5 of the *Hillman*
08:57:38AM 10 decision, and I've omitted internal quotations and citations.

11 I find the *Hillman* analysis and logic to be equally
12 applicable here. There is no evidence that there are any
13 current or past Vitamin Health products that would not be
14 subject to the benefits afforded by dismissing the '522 claims
08:57:59AM 15 with prejudice.

16 There is no evidence or suggestion that Vitamin
17 Health has made "meaningful preparations" for future products
18 or future activity that could be considered infringing on the
19 '522 patent.

08:58:13AM 20 And as I previously explained, an actual case or
21 controversy sufficient to confer federal jurisdiction cannot
22 be based on a fear Vitamin Health may have over future
23 litigation with respect to future products.

24 The same analysis holds true for Bausch & Lomb's
08:58:30AM 25 motion to dismiss Count 3 of the complaint with respect to

1 alleged false advertising as to Vitamin Health's marketing of
2 its 25 milligram zinc products. By dismissing these claims
3 with prejudice, Vitamin Health is put in the same position as
4 it would be had it prevailed at trial.

08:58:48AM 5 For these reasons Vitamin Health's motion to
6 dismiss claims 2 and 3 is granted.

7 Now, how does that simplify your case?

8 **MR. DOMBROWSKI:** I think for each of our experts, it
9 reduces the testimony they're going to be giving.

08:59:09AM 10 **MAGISTRATE JUDGE FELDMAN:** We would have the same
11 number of witnesses, but expert testimony would be limited to
12 the --

13 **MR. DOMBROWSKI:** Correct. I don't think our witness
14 list changes as a result.

08:59:19AM 15 **MR. KLINE:** Doesn't remove any witnesses. It may
16 remove some of the deposition designations, but that's --

17 **MAGISTRATE JUDGE FELDMAN:** Can you let me know by
18 the end of today? Because I don't want to spend time going
19 over depositions that I don't have to.

08:59:31AM 20 How about from your point of view?

21 **MR. TOBIN:** Your Honor, I think it may make some
22 changes. I've got a quick question of clarification on that,
23 though.

24 You mentioned at the end of the decision 25
08:59:40AM 25 milligram zinc products. Just to clarify, the Order of

1 Dismissal with prejudice relates to all of Vitamin Health's
2 current products as well as the products that are covered by
3 the patent, which would include Vitamin Health's 80 milligram
4 products -- both 80 milligram zinc, 2 milligrams of copper as
09:00:01AM 5 well as 80 milligrams of zinc, 2.8 milligrams of copper.

6 **MAGISTRATE JUDGE FELDMAN:** Any false advertising
7 claim made with respect to the '522 patent is dismissed with
8 prejudice.

9 **MR. TOBIN:** On the patent side, it's any of Vitamin
09:00:15AM 10 Health's products?

11 **MAGISTRATE JUDGE FELDMAN:** Past or current products.

12 **MR. TOBIN:** Okay, thank you.

13 **MAGISTRATE JUDGE FELDMAN:** Okay, with respect to --

14 **MR. TOBIN:** Your Honor, just -- I'm sorry. So the
09:00:35AM 15 '522 patent's claim is dismissed with prejudice as it relates
16 to any of Vitamin Health's current or former products.

17 And then the false advertising claim is just
18 dismissed with prejudice as relates to everything that was
19 described in the complaint, correct?

09:00:52AM 20 **MAGISTRATE JUDGE FELDMAN:** Do you agree with that?

21 **MR. KLINE:** I think so. I think he's referring
22 to the false advertising claim that we had in our Count 3,
23 yeah.

24 **MAGISTRATE JUDGE FELDMAN:** Okay. You won the false
09:01:07AM 25 advertising claim in Count 3. Whatever -- whatever you --

1 benefit you could have gotten from that you now have.

2 **MR. SUSSEER:** Your Honor, on the question of
3 streamlining -- is it okay if I sit?

4 **MAGISTRATE JUDGE FELDMAN:** Yes.

09:01:21AM 5 **MR. SUSSEER:** Other than it will take out some of the
6 testimony that we would otherwise adduce, it will not change
7 our witnesses, nor materially effect the exhibits we intend to
8 put in.

9 **MAGISTRATE JUDGE FELDMAN:** How about the
09:01:32AM 10 designations?

11 **MR. SUSSEER:** It may effect -- I don't think it will
12 eliminate any deponents. It will probably, as Mr. Kline said
13 on his side, limit some of the designations.

14 **MAGISTRATE JUDGE FELDMAN:** If any of the eliminated
09:01:47AM 15 designations have objections, will you let me know by the end
16 of today?

17 **MR. SUSSEER:** Yes, Your Honor.

18 **MAGISTRATE JUDGE FELDMAN:** Okay.

19 Okay, let's move then to the letters regarding
09:02:00AM 20 these designations or excerpts of Meyering, Balaram and
21 Ferris.

22 **MR. SUSSEER:** Your Honor, first I want to thank the
23 Court for scheduling this hearing to discuss this. I think
24 it's an important issue and one that will serve everyone well
09:02:16AM 25 if we can decide in advance.

1 A large portion of this case relates to the
2 allegations by Bausch & Lomb that 25 milligrams is equivalent
3 to 60 to 100 milligrams under the Doctrine of Equivalents.

4 The Doctrine of Equivalents measures insubstantial
09:02:33AM 5 differences or the same function-way-result. Basically, it's
6 an interchangeability theory, you can interchange 25 for 80
7 and 80 for 25.

8 A second issue that's related is whether Vitamin
9 Health willfully infringed the '297 patent under the Doctrine
09:02:54AM 10 of Equivalents by knowingly -- with an unjustifiably high risk
11 making, using or selling that 25 milligram product.

12 The testimony that we would like to adduce is
13 testimony -- and actually goes beyond, somewhat beyond these
14 designations -- there are other witnesses who will testify to
09:03:13AM 15 it and documents that relate to it -- is Bausch & Lomb or its
16 agents, and one individual -- and at least one individual from
17 the NEI have said no, 25 is not the same or equivalent to 80
18 milligrams, which falls within the 60 to 100 range.

19 **MAGISTRATE JUDGE FELDMAN:** None of these
09:03:33AM 20 designations say that.

21 **MR. SUSSER:** They do say that 25 and 80 are
22 different. They say --

23 **MAGISTRATE JUDGE FELDMAN:** Just going over them, Mr.
24 Meyering, who is Mr. Meyering?

09:03:47AM 25 **MR. DOMBROWSKI:** He's Bausch & Lomb's -- an

1 executive at Bausch & Lomb.

2 **MAGISTRATE JUDGE FELDMAN:** Okay.

3 **MR. DOMBROWSKI:** Most of that testimony, the answers
4 were I don't know.

09:03:54AM 5 **MAGISTRATE JUDGE FELDMAN:** That's what I'm saying.
6 The first one I got -- and I appreciate you blowing this up
7 because usually I have to wear these, but when I got it I
8 didn't have to wear it.

9 Do you believe it also covers 25 milligrams of
09:04:05AM 10 zinc? I'm looking at the excerpt that was given to me.

11 Witness: I don't know.

12 **MR. SUSSEER:** I don't know what you mean by
13 equivalent he writes -- or his answer is.

14 **MAGISTRATE JUDGE FELDMAN:** I don't have that. I
09:04:23AM 15 just have one page.

16 **MR. SUSSEER:** Oh, sorry.

17 **MAGISTRATE JUDGE FELDMAN:** That's what I have.

18 **MR. SUSSEER:** Let me get Meyering. I just -- before
19 we go down this route, and I'm happy to -- these are
09:04:35AM 20 representative of the issue.

21 **MAGISTRATE JUDGE FELDMAN:** Well, if these are your
22 best representations, I think we have a problem. Let me tell
23 you where I'm coming from. You know, the cases that I've read
24 say this Doctrine of Equivalents is a question -- Doctrine of
09:04:51AM 25 Equivalents is a question for experts, or at least a person of

1 ordinary skill in the art.

2 I don't know from these designations that even if
3 this was a person of ordinary skill in the art and you
4 qualified for that position, that there's anything here that
09:05:15AM 5 would be admissible.

6 Meyering is I don't know, at least -- and all I'm
7 going on is the excerpts you provided.

8 Balaram, who is Balaram?

9 **MR. KLINE:** She's a former Bausch & Lomb employee
09:05:27AM 10 who was in the Medical Department, I guess, helping with
11 marketing.

12 **MR. DOMBROWSKI:** Can I add, Your Honor, too, that
13 Meyering is a marketing person, too, to give you his role at
14 Bausch & Lomb.

09:05:37AM 15 **MAGISTRATE JUDGE FELDMAN:** I don't know who these
16 people are. I'm just basing it on what I have.

17 Are those two products equivalent?

18 Answer: I don't know what you mean by equivalent.

19 Question: The same.

09:05:46AM 20 Answer: They're different. Obviously one has more
21 zinc than the other.

22 Okay. Do they have the same effect?

23 I don't know. Effect for what?

24 It goes on, and on the next page at line 14 and 15,
09:06:01AM 25 the same purpose as it relates to age-related macular

1 degeneration?

2 Answer: I don't know.

3 The last page: I don't have the expertise to say
4 categorically yes.

09:06:12AM 5 Question: So you don't know?

6 Answer: Yes, I don't know.

7 Now, I want to leave the Ferris thing alone for a
8 second, but with respect to those two, unless there's a better
9 foundation made that this is a person of skill in the art
09:06:26AM 10 that's capable of giving an opinion on the Doctrine of
11 Equivalents as to whether the differences are insubstantial, I
12 wouldn't allow it on the basis of relevance.

13 There's nothing -- there's no opinion here upon
14 anything.

09:06:44AM 15 **MR. SUSSER:** Your Honor, if I may?

16 **MAGISTRATE JUDGE FELDMAN:** Yeah.

17 **MR. SUSSER:** Couple things. I'm happy to -- there
18 are more -- there are more references. We're trying, in the
19 interest of time --

09:06:54AM 20 **MAGISTRATE JUDGE FELDMAN:** I thought you gave me
21 your best ones?

22 **MR. SUSSER:** Actually, they're not the best ones,
23 okay? So we have -- if you want better ones where they
24 actually say they're not the same -- with AREDS 2 was not
09:07:08AM 25 powered to test equivalence.

1 Remember, what they're saying, Your Honor, is 25 is
2 obviously different from 80, but AREDS 2 converts 80 into 25.
3 AREDS 2 basically says they're equivalent.

4 And there are witnesses, their witnesses, several,
09:07:24AM 5 who say the AREDS 2 study is not powered to make -- to test
6 equivalence. It's not designed to test equivalence.

7 And Dr. Bressler, their expert, says that. Rick
8 Ferris, Dr. Ferris of the NEI, says that. Emily Chew of the
9 NEI says that.

09:07:43AM 10 **MAGISTRATE JUDGE FELDMAN:** Who is going to be
11 testifying on the Doctrine of Equivalents for Bausch & Lomb?

12 **MR. DOMBROWSKI:** Dr. Johnson.

13 **MAGISTRATE JUDGE FELDMAN:** Dr. Johnson, you can
14 cross-examine her until the cows come home on it.

09:07:52AM 15 **MR. SUSSER:** But, Your Honor, what we would want to
16 do -- what I think would be very important for the jury,
17 especially since it's the subjective -- we're being attacked
18 for willful infringement, that we knowingly infringed.

19 **MAGISTRATE JUDGE FELDMAN:** That's your state of
09:08:07AM 20 mind. Whether they thought it was equivalent or not is
21 irrelevant to your state of mind.

22 **MR. SUSSER:** Well, I don't think it's irrelevant,
23 Your Honor, insofar as if the jury hears that Bausch, Bausch
24 representatives, Bausch's expert, the NEI believe (a) 25 is
09:08:27AM 25 not equivalent to 80; and (b), that the AREDS 2 study was not

1 designed to test that equivalency, the jury will be more
2 likely to believe Aaron's view that he did not think that they
3 were equivalent.

4 **MAGISTRATE JUDGE FELDMAN:** I haven't seen that
09:08:40AM 5 testimony, if you have that testimony. It's just not in the
6 submissions that you made.

7 Now, we don't have a lot of time here. I'm basing
8 my ruling on what you've given me. If you have other evidence
9 that's better than this, I'll consider it, but I forget the
09:08:54AM 10 name of the case, it's the Aqua something case, Federal
11 Circuit, which lays out what you need to do to prove the
12 Doctrine of Equivalents.

13 And don't get me wrong here, okay? I don't think
14 their position on the Doctrine of Equivalents is a slam dunk.
09:09:15AM 15 Far from it, okay? Just because they say it's equivalent
16 doesn't mean it's equivalent.

17 And whether the jury would find 25 and 80
18 equivalent, you know, that's what the jury's for.

19 But the proof that's admissible on that has really
09:09:30AM 20 been defined by the Federal Circuit. And it's got to be from
21 someone, not a lay person, but someone who is qualified as a
22 person of ordinary skill in the art.

23 I don't necessarily think it has to be someone who
24 is qualified as an expert, but I do think it has to be someone
09:09:53AM 25 who is qualified as a person of skill in the art, to offer

1 their opinion on either the three factor test or on whether
2 the differences are insubstantial; whether the competitor's
3 changes are so insubstantial that it's unfair to the patent
4 holder.

09:10:15AM 5 And, you know, what I would prefer, if you make a
6 further motion on this, is to give me some cases where this
7 type of testimony you're offering would be admissible.

8 I'm hesitating on the third witness, which is the
9 inventor. Is this witness testifying live, or no?

09:10:39AM 10 **MR. DOMBROWSKI:** No.

11 **MAGISTRATE JUDGE FELDMAN:** Okay. You know, the
12 excerpts that you gave me, I think they would be a person
13 qualified in the skill of the art -- or excuse me, a person of
14 ordinary skill in the art, regardless of whether they're
09:10:55AM 15 proffered as an expert or not.

16 But the testimony you're giving me doesn't support
17 what you want to use it for. You know, I don't know what you
18 mean by equivalent. They're different. Okay. Do they have
19 the same effect? I don't know. Excuse me, I'm looking at the
09:11:14AM 20 wrong one.

21 He goes I don't understand the question, but I'll
22 answer it to the best of my ability. I'm looking at the last
23 page of the submission you gave me, and the answer is the same
24 as I just gave you before , we talked to Bausch & Lomb, asked
09:11:27AM 25 them to create a formulation that would have, in this case, 80

1 milligrams of zinc on the formulation, and whatever they did,
2 that's what they did. I don't -- I wouldn't second-guess
3 them.

4 I really don't understand that answer because
09:11:39AM 5 there's no context to it, but that one, if there was context
6 to it, he is the inventor, I assume it's a he --

7 **MR. DOMBROWSKI:** Yes.

8 **MAGISTRATE JUDGE FELDMAN:** -- I think I'd allow it
9 if there was some context to it.

09:11:53AM 10 **MR. DOMBROWSKI:** Your Honor, part of it is not just
11 asking who they were asking of the other witnesses, but all of
12 these questions they're just asking about equivalent and
13 sameness, just using those words.

14 They're not laying out the test. So even if this
09:12:04AM 15 was a proper person, they're not setting up this question to
16 get the right answer.

17 **MAGISTRATE JUDGE FELDMAN:** So that's why -- I've got
18 redacted deposition testimony. I really need more than I have
19 here.

09:12:13AM 20 But of the three of them, I think this is a person
21 that would be of ordinary skill in the art. And if they
22 actually had testimony that would be relevant to the Doctrine
23 of Equivalents, I think I'd allow it.

24 **MR. SUSSEER:** Your Honor, may I respond?

09:12:28AM 25 **MAGISTRATE JUDGE FELDMAN:** Yes.

1 **MR. SUSSER:** I'll confess, this is a very important
2 issue for Vitamin Health so I do want to fight -- give it my
3 best fight.

4 I did not put forward the best excerpts. I will do
09:12:39AM 5 that, and we will submit to the Court by Monday morning
6 excerpts that are representative of those two points. One,
7 that the AREDS 2 study was not powered to test equivalency;
8 and number two, that people on their side, people of ordinary
9 skill in the art believe them not to be equivalent.

09:13:00AM 10 I would say this, however, if I could just finish?

11 **MAGISTRATE JUDGE FELDMAN:** Mm-hmm.

12 **MR. SUSSER:** Dr. Johnson defines a person of
13 ordinary skill in the art, what she believes. First she says
14 it's someone with a medical type degree in eye health, and
09:13:14AM 15 some experience with visual loss.

16 Then she says "alternatively, a POSA, person of
17 ordinary skill in the art, at the time could have been a
18 person with a bachelor's degree with a greater number of years
19 of experience.

09:13:31AM 20 Now, all the people that we are proposing meet
21 Dr. Johnson's own definition of person of ordinary skill in
22 the art. That's the first point.

23 The second point is --

24 **MAGISTRATE JUDGE FELDMAN:** Let me say this: I have
09:13:44AM 25 a bachelor's degree and I wouldn't be an ordinary -- a person

1 of ordinary skill in the art. I think it's got to be
2 something more than having a bachelor's degree. It's got to
3 be a bachelor's degree in some specific area of --

4 **MR. SUSSEER:** She says with a greater number of years
09:13:57AM 5 of -- I'm quoting exactly.

6 **MAGISTRATE JUDGE FELDMAN:** Greater number of what
7 years?

8 **MR. SUSSEER:** Years of experience in -- in the
9 nutritional supplement area, including --

09:14:07AM 10 **MAGISTRATE JUDGE FELDMAN:** Okay.

11 **MR. SUSSEER:** -- so all of these people have many
12 years of experience in the nutritional supplement area and a
13 bachelor's degree at the minimum.

14 Now, Dr. Balaram was the medical head of this
09:14:18AM 15 particular product.

16 Robert Meyering has worked in this field for 30, 40
17 years first at stores, then at Bausch. He knows this stuff,
18 he markets it, he sells it, he talks about it all the time.
19 These are people who actually know. They are people who are
09:14:32AM 20 ordinary skill in the art.

21 Then I would cite the Court to the *Hilton Davis*
22 *Chem Co. vs. Warner Jenkinson* where the Federal Circuit
23 en banc said we're going to restate our position on Doctrine
24 of Equivalents. And one of the things they say, and I have
09:14:47AM 25 this decision here --

1 **MAGISTRATE JUDGE FELDMAN:** I'm familiar with the
2 decision.

3 **MR. SUSSER:** They focus on is it interchangeable to
4 a person of ordinary skill in the art. All of the quotes
09:14:55AM 5 that -- I will give the quote Monday morning on this subject,
6 on the subject of this, are we don't think it's
7 interchangeable. They are people of ordinary skill in the art
8 who say this is not interchangeable.

9 That's critical for us to get in front of the jury
09:15:10AM 10 not only to defend against infringement on 25, but on
11 willfulness as well.

12 And so when the jury hears, we believe, that
13 Dr. Ferris of the NEI, Dr. Chew of the NEI, Susan Bressler,
14 Dr. Bressler their expert witness, Robert Meyering, John
09:15:31AM 15 Ferris, Mimi Balaram the medical director, they're all saying
16 AREDS 2 is not powered for equivalence, number one.

17 And number two --

18 **MAGISTRATE JUDGE FELDMAN:** What's that mean, AREDS 2
19 is not powered for equivalence?

09:15:44AM 20 **MR. SUSSER:** It means the study was not designed to
21 test whether they were equivalent. You can't say that.

22 Dr. Bressler said, look, you can't say they're
23 equivalent with the testing that was done on AREDS 2. It's
24 inadequate.

09:15:54AM 25 It was a limited test for limited purposes and it

1 wasn't designed -- the study itself doesn't purport to be an
2 equivalency study.

3 So when they hear that, Your Honor, that is going
4 to help our defense enormously, we believe, which is why it's
09:16:08AM 5 so important.

6 These are all people of ordinary skill in the art,
7 they're experts in this field, in the nutritional field, and
8 they've all said it's not interchangeable.

9 Under the *Hilton Davis* case --

09:16:20AM 10 **MAGISTRATE JUDGE FELDMAN:** Okay, let me cut this
11 short a little bit. There's two issues here. One I've said,
12 I think it's the Aqua Tek case, it may be T-E-K, that deals
13 with, you know, what type of testimony is relevant to the
14 Doctrine of Equivalents, but it's got to be somebody -- a
09:16:39AM 15 person of ordinary skill in the art.

16 But, second of all, even if you had that person,
17 you have to show that the testimony you're offering says what
18 you say it says, and right now it doesn't, at least with these
19 experts.

09:16:53AM 20 **MR. SUSSER:** That's fair. And that's because I
21 mischosed my excerpts. Please allow me, Your Honor, by Monday
22 to give you some better experts.

23 **MAGISTRATE JUDGE FELDMAN:** I will. And if you have
24 a memorandum of law attached which sets forth, particularly on
09:17:06AM 25 this issue of willfulness, how testimony on the Doctrine of

1 Equivalents can be transferred to the issue of willfulness, I
2 would be interested in that too.

3 **MR. SUSSER:** In the meantime, Your Honor, could I
4 hand to the Court -- and of course opposing counsel -- a short
09:17:19AM 5 evidentiary memorandum that we prepared with the *Hilton Davis*
6 case?

7 **MAGISTRATE JUDGE FELDMAN:** Okay.

8 **MR. DOMBROWSKI:** Can I make one point, Your Honor?
9 Of the witnesses he listed, at least a couple of them are not
09:17:29AM 10 persons of ordinary skill in the art. Mr. Meyering is a
11 marketing guy, like I said earlier. So he's conflating a lot
12 of witnesses here of what we're talking about.

13 **MAGISTRATE JUDGE FELDMAN:** Right. If there's a
14 dispute of that, then I would have questions asked outside the
09:17:42AM 15 presence of the jury and I would have to make a determination
16 whether the person is --

17 **MR. DOMBROWSKI:** Sure, I just wanted to clarify
18 that, you know.

19 **MAGISTRATE JUDGE FELDMAN:** Okay. This is not
09:17:49AM 20 something that's going to come up Monday or Tuesday in the
21 trial?

22 **MR. SUSSER:** I would like to raise it in my
23 opening.

24 **MAGISTRATE JUDGE FELDMAN:** Okay. Well, as of now
09:17:57AM 25 you can't, but I'll take a look at what you give me on Monday.

1 **MR. SUSSER:** Thank you, Your Honor.

2 **MAGISTRATE JUDGE FELDMAN:** Okay. Okay, to be
3 decided is Bausch & Lomb's motion for summary judgment on
4 validity. We plan on issuing that today.

09:18:24AM 5 Also, Vitamin Health's lone remaining summary
6 judgment motion or partial summary judgment motion, the lone
7 remaining issue is the prosecution estoppel argument. We hope
8 to issue a written decision on that today.

9 With respect to the submissions I asked for on what
09:18:45AM 10 questions would be given to the jury and what questions would
11 be given or made -- determinations would be made by the Court,
12 on July 26th I issued a decision and I set forth for the
13 parties what issues would be resolved by the Court and what
14 issues would be determined by the jury.

09:19:20AM 15 With respect to enablement I said, based on the
16 law, that this was a question for the Court to resolve, but if
17 there were factual disputes over an event, I would allow the
18 jury to resolve that dispute through a specific interrogatory
19 question.

09:19:43AM 20 I tried to make clear in my Decision and Order that
21 I issued on the 26th that what I was looking for was a genuine
22 factual dispute over an event as opposed to simply competing
23 expert opinions about the legal significance of an undisputed
24 fact or event.

09:20:04AM 25 I've reviewed the questions on enablement that I

1 have received from Vitamin Health. Based on my review, I
2 don't believe these questions are regarding a factual dispute
3 as to enablement, but really the questions that go to the
4 ultimate determination that I need to make in whether a person
09:20:26AM 5 of ordinary skill in the art -- excuse me, whether the
6 specification describes the invention in such a way to enable
7 a person of ordinary skill in the art to make and use the
8 invention.

9 So that the questions that are posed by Vitamin
09:20:48AM 10 Health, to the extent they need to be answered, will be
11 answered by the Court based upon evidence at trial, and I will
12 not be submitting those particular questions to the jury
13 because I think they are the ultimate issue that needs to be
14 decided and not really a factual -- genuine factual dispute.

09:21:06AM 15 With respect to the schedule --

16 **MR. DOMBROWSKI:** Your Honor, can I ask about that
17 last issue? A few of the equitable defenses have not clearly
18 been laid out as going to the Court, but I think you mentioned
19 in the first pretrial conference, which we don't have a
09:21:22AM 20 transcript of, that they will be going to you, which are
21 laches, acquiescence, waiver and equitable estoppel.

22 **MAGISTRATE JUDGE FELDMAN:** I don't think there were
23 any dispute as to those. That's why I didn't.

24 **MR. DOMBROWSKI:** Just clarifying. Thank you.

09:21:30AM 25 **MAGISTRATE JUDGE FELDMAN:** So I want to talk about

1 the schedule. I'm thinking that the dropping of those two
2 counts and the summary judgment motion may have shortened the
3 trial. Am I correct on that?

4 **MR. KLINE:** Your Honor, that's correct. And just so
09:21:51AM 5 you know, we have spoken to the other side about streamlining
6 the number of products, and we've grouped them -- I think
7 we're in agreement -- we have six groups of the 16 products.

8 We're down to one representative product from each
9 of those groups. Now, three of those groups were the subject
09:22:10AM 10 of the summary judgment, so we're not going to have to walk
11 through all those.

12 So we're really down to, at least for infringement,
13 just three groups with one representative product for each
14 one.

09:22:20AM 15 And we're only asserting claims 1, 19 and 31, which
16 are the same ones that were part of the summary judgment
17 motion. So I think that does streamline it quite a bit.

18 The other thing, we're working with them is how to
19 handle -- obviously, because of the ruling on summary judgment
09:22:39AM 20 on some of the part, you know, some of it has applicability to
21 these other products because they kept all the ingredients the
22 same except changed one, and we're trying to work with them
23 on, hopefully, a stipulation where we can come to something
24 like based on the Court's claim construction, the parties
09:22:58AM 25 agree it literally meets claims, you know, element A, B and C.

1 The only issue to be presented is 2.8. And that will
2 streamline it too.

3 **MAGISTRATE JUDGE FELDMAN:** Are you confident you'll
4 reach agreement on that?

09:23:12AM 5 **MR. KLINE:** Unfortunately, I've been speaking with
6 Mr. Carlson, and he's not here. But it's my understanding
7 they're agreeable to that.

8 And if -- I guess Mr. Tobin or Mr. Susser can tell
9 me differently.

09:23:26AM 10 **MR. TOBIN:** I think we've generally narrowed and
11 we're in agreement. I think there may be one or two minor
12 issues left as it relates to one of the groupings, but
13 generally I think we're in agreement.

14 **MAGISTRATE JUDGE FELDMAN:** Okay. And you'll have
09:23:37AM 15 the physical products that you're going to use in court?

16 **MR. KLINE:** Correct, to the extent -- yeah, right.

17 **MR. DOMBROWSKI:** I think we do have physical
18 exhibits, yes.

19 **MAGISTRATE JUDGE FELDMAN:** How much shorter do you
09:23:55AM 20 think that makes your presentation?

21 **MR. KLINE:** We haven't added it up. Certainly it
22 cuts out a lot because of the inducement and the false
23 advertising issues. I would say -- I would say it probably
24 reduced it 25% at least.

09:24:17AM 25 **MAGISTRATE JUDGE FELDMAN:** Okay. With respect to

1 damages, how are you handling the damage testimony for the
2 products that summary judgment's granted on?

3 **MR. KLINE:** We have updated the damage reports based
4 on the updated sales numbers. We have broken it out by these
09:24:36AM 5 groupings -- the 80 2.0, the 80 2.8 milligram of copper and
6 the 25 milligram.

7 **MAGISTRATE JUDGE FELDMAN:** How do you propose
8 to explain to the jury that they're going to be considering
9 damages on products that they're not hearing about?

09:24:52AM 10 **MR. KLINE:** Well, I'm assuming there would be some
11 sort of stipulation because -- saying that these products have
12 already been found to infringe, but they still have their
13 validity argument on.

14 **MAGISTRATE JUDGE FELDMAN:** I'm not sure I'm going to
09:25:04AM 15 tell the jury these products have been found to infringe. I
16 think we've got to work out a sanitized stipulation that
17 you're being asked to determine on these, you're not to
18 consider whether they infringe or not. I think that's --

19 **MR. SUSSEER:** I'm worried that if the jury hears that
09:25:18AM 20 you've made a decision, they will be against us.

21 **MAGISTRATE JUDGE FELDMAN:** So I'd like you to work
22 out a different stipulation on that.

23 **MR. SUSSEER:** Yes, we will, Your Honor, we'll propose
24 something.

09:25:31AM 25 **MAGISTRATE JUDGE FELDMAN:** Okay. So I'm interested

1 to know your thoughts on a schedule. My current thinking now
2 is to start at 8:30 and go to 1:30, take two breaks -- this is
3 with the jury; and then use the afternoon, maybe come back at
4 2:30 or so for testimony on issues that will solely be before
09:25:58AM 5 me.

6 **MR. SUSSEER:** I think that could work, Your Honor.

7 **MAGISTRATE JUDGE FELDMAN:** Who are the witnesses
8 that are going to testify on the equitable or the legal
9 issues?

09:26:12AM 10 **MR. KLINE:** They're their issues, so I'm not
11 certain.

12 **MR. SUSSEER:** On the equitable issues, Your Honor,
13 estoppel and laches, that would be Mr. Shepherd, Aaron
14 Shepherd.

09:26:28AM 15 **MAGISTRATE JUDGE FELDMAN:** So he's going to be here
16 for the whole trial anyway, right?

17 **MR. SUSSEER:** He will be.

18 **MAGISTRATE JUDGE FELDMAN:** All right. So we'll be
19 able to fit him in, okay.

09:26:39AM 20 **MR. SUSSEER:** Your Honor, if I could just come back
21 to one point? We can get the Court those excerpts by
22 1 o'clock today. Would it be, just to avoid Tuesday -- Monday
23 morning, would it be possible to come back this afternoon and
24 just --

09:26:53AM 25 **MAGISTRATE JUDGE FELDMAN:** I'm out this afternoon,

1 which is why I want to do it this morning.

2 **MR. SUSSEER:** Yes.

3 **MAGISTRATE JUDGE FELDMAN:** I'm going to be working
4 on this all weekend, so if you get it to me --

09:27:01AM 5 **MR. SUSSEER:** We'll get it to you this afternoon for
6 sure, Your Honor. I do appreciate that.

7 There was one issue in the letter we didn't address
8 and that was the cross-examination issue.

9 **MAGISTRATE JUDGE FELDMAN:** Explain that to me.

09:27:10AM 10 **MR. SUSSEER:** Sure. Basically what I'm proposing is
11 the same arrangement that we have for Aaron Shepherd, which is
12 we will call Mr. Shepherd in our case-in-chief, but they will
13 be able to cross-examine him not only on what we ask him
14 about, but anything -- any topic that they've designated from
09:27:29AM 15 his deposition. So they automatically get a wider swath of
16 territory for cross-examination.

17 We want to do the same thing for Mr. Meyering and
18 Mr. John Ferris, their two fact witnesses. To the extent
19 those individuals don't talk about something being equivalent,
09:27:49AM 20 for example, we want to be -- assuming the Court allows it in
21 eventually, we would want to be able to ask them that, about
22 that. And we've designated testimony that would be the topics
23 we want to ask them about.

24 They've said -- of course they agreed to Mr.
09:28:04AM 25 Shepherd, but they said no as to Meyering and Ferris. They

1 said maybe you can read them to the jury with our counter
2 designations and objections and we don't want to do that. We
3 already have too much to read to the jury, the jury's going to
4 be bored.

09:28:15AM 5 We want -- the witnesses are up there, we're
6 telling them the topics. It's just their deposition
7 testimony.

8 **MAGISTRATE JUDGE FELDMAN:** What are the topics
9 beyond equivalence?

09:28:26AM 10 **MR. SUSSER:** I can't think of any, Your Honor.

11 **MAGISTRATE JUDGE FELDMAN:** So it really depends on
12 my ruling?

13 **MR. SUSSER:** I'd have to go back and double check
14 Meyering and Ferris, but I'm pretty sure most of them would
09:28:40AM 15 be on the Doctrine of Equivalents and whether something is
16 interchangeable. And so I think the answer is a qualified
17 yes.

18 **MAGISTRATE JUDGE FELDMAN:** Have you designated all
19 those sections that you want to ask them about?

09:28:53AM 20 **MR. SUSSER:** Yes, Your Honor.

21 **MAGISTRATE JUDGE FELDMAN:** Are those designations
22 that I have already?

23 **MR. SUSSER:** Yes, Your Honor.

24 **MAGISTRATE JUDGE FELDMAN:** Okay. So you want to be
09:28:59AM 25 able to question them live on that?

1 **MR. SUSSER:** Cross-examine them after they finish
2 their direct, even if it's not raised on direct.

3 **MAGISTRATE JUDGE FELDMAN:** Okay.

4 **MR. DOMBROWSKI:** Your Honor, a few points on that.
09:29:09AM 5 One, back to my earlier point, Meyering and John Ferris are
6 not experts, they're POSA's.

7 So the Doctrine of Equivalents and the scope of the
8 patent claim questions we think is inappropriate for them as
9 an initial matter.

09:29:20AM 10 Second of all, Mr. Susser makes it seem like we
11 wanted this Aaron Shepherd deal. This is something they
12 approached us about to have this accomodation so that we
13 didn't preempt his live testimony by playing his video or
14 reading his transcript. So it's not like we're seeking this
09:29:32AM 15 arrangement.

16 And for our witnesses we don't want that
17 arrangement. We don't want the cross blown wide up. We would
18 rather have them play the properly 30(b)(6) designated
19 testimony in their case-in-chief.

09:29:43AM 20 **MAGISTRATE JUDGE FELDMAN:** Or they could call them
21 in their case?

22 **MR. DOMBROWSKI:** They could, although I'll note they
23 did not list them on their list of witnesses.

24 **MR. SUSSER:** Actually, we did, Your Honor. We
09:29:51AM 25 referenced their witness list, we listed them and their

1 Rule 30(b)(6) deponents, both of them.

2 And the testimony we're asking them about is
3 largely, not exclusively, is Rule 30(b)(6) testimony which can
4 be used for any purpose at trial.

09:30:04AM 5 **MAGISTRATE JUDGE FELDMAN:** Assuming I rule that
6 there's something on the Doctrine of Equivalents that they can
7 ask him about, which right now I haven't seen anything, but
8 assuming I see something, do you want to bring them back or do
9 you want to allow him to be asked?

09:30:21AM 10 **MR. DOMBROWSKI:** Just allow him to be asked on cross
11 I suppose.

12 **MAGISTRATE JUDGE FELDMAN:** That's up to you. I'm
13 not going to force you to do anything. There's a lot of
14 strategy that goes into these cases, I know that, I've tried
09:30:35AM 15 cases.

16 So I'm going to let you try your own case, but it's
17 really an inconvenience to your witness, I guess, that you
18 have to weigh.

19 **MR. DOMBROWSKI:** Sure, and he's from Florida. I
09:30:42AM 20 mean, we can work it out. I just don't know on the spot.

21 **MAGISTRATE JUDGE FELDMAN:** Okay. I'm not forcing
22 them to do that. I'm going to first find out if there's
23 anything -- because right now there isn't anything, but you're
24 going to get me something by 1 o'clock today, I want to give
09:30:53AM 25 you a chance to respond to it. Maybe by the close of business

1 if you get it by 1?

2 **MR. DOMBROWSKI:** Can I make one other point? We
3 have served them our objections and counter designations to
4 their designations for Mr. Meyering and Mr. Ferris.

09:31:05AM 5 But we have not had the whole procedure back and
6 forth. We've not seen their objections to our counter
7 designations because they were given to us, you know, that
8 process has not played out yet.

9 So I'm not sure it's possible to do that by this
09:31:17AM 10 afternoon, but we can try, but just we have not had the back
11 and forth yet on that.

12 **MR. SUSSEER:** Our --

13 **MAGISTRATE JUDGE FELDMAN:** I thought you said you
14 designated the Doctrine of Equivalent testimony you want for
09:31:25AM 15 these witnesses?

16 **MR. SUSSEER:** We did. We gave it to them and they
17 objected and counter designated.

18 Our position is we don't want -- we don't need to
19 go through that. You can question him on anything you want on
09:31:36AM 20 direct, you can redirect him on that, you can object to our
21 questions at trial if you want.

22 We're asking that it not be done through a
23 deposition designation process.

24 **MR. DOMBROWSKI:** I guess the reason why I bring that
09:31:49AM 25 up is, for instance, the quote from Mr. Meyering that they

1 gave you in the letter is not properly within the 30(b)(6)
2 scope.

3 So, I mean, that's not even -- there is no 30(b)(6)
4 topic for Mr. Meyering on the scope of the patent claims, for
09:32:01AM 5 instance, and that's what -- the question was asked to him on
6 that particular portion they gave you.

7 So that's noted in our objections that we provided
8 them.

9 **MR. SUSSER:** They can object -- if they want, they
09:32:13AM 10 can object at trial if I ask a cross question. I don't
11 believe that I will.

12 I believe what I'll ask is -- it doesn't need --
13 he's a fact witness and he's a 30(b)(6) witness, he's
14 testifying as both. He has personal knowledge because he
09:32:25AM 15 lived through all this; he was the NEI's -- chief communicator
16 with the NEI, et cetera. So he's a personal witness, he's a
17 Rule 30(b)(6).

18 Most of the topics, if not all, are -- that I will
19 want to ask him about on cross are Rule 30(b)(6) topics. That
09:32:39AM 20 was key. He testified on a lot of those issues.

21 **MR. DOMBROWSKI:** My response is just that particular
22 portion at least they gave you in the letter is not properly
23 30(b)(6).

24 **MAGISTRATE JUDGE FELDMAN:** Okay, let's look at that
09:32:50AM 25 for a second. If, for example, he convinces me that this is a

1 person of skill in the art, and that there's something that
2 he's testified about that goes to a relevant issue on the
3 Doctrine of Equivalents --

4 **MR. DOMBROWSKI:** And is properly 30(b)(6) within
09:33:04AM 5 the scope of their topics.

6 **MAGISTRATE JUDGE FELDMAN:** Let's say it's not within
7 the scope of their topics.

8 **MR. DOMBROWSKI:** Then they don't have a right to
9 play the deposition in their case-in-chief if he's --

09:33:11AM 10 **MAGISTRATE JUDGE FELDMAN:** No, no, he's not playing
11 the deposition. He's going to ask him live.

12 **MR. DOMBROWSKI:** Okay.

13 **MAGISTRATE JUDGE FELDMAN:** Right?

14 **MR. SUSSER:** Right. This isn't scripted. This is
09:33:17AM 15 cross-examination.

16 **MAGISTRATE JUDGE FELDMAN:** Yeah, he's going to ask
17 him live.

18 **MR. DOMBROWSKI:** We're already at the point where
19 that's -- okay.

09:33:23AM 20 **MAGISTRATE JUDGE FELDMAN:** We're far ahead of where
21 we are now. I haven't made a ruling on any of this. I'm
22 assuming that he gives me something that says -- from some
23 expert that says this person has -- not an expert. From
24 someone of position of skill in the art, that they have
09:33:37AM 25 something that's relevant to the Doctrine of Equivalents.

1 **MR. DOMBROWSKI:** My response to that is the deal we
2 made with Aaron Shepherd is that on our cross-examination of
3 him we can go outside the scope of the direct for -- that is
4 within the scope of what we designated properly 30(b)(6) in
09:33:52AM 5 his transcript.

6 So to the extent they're going to try to go outside
7 the scope of the direct with Mr. Meyering on testimony that's
8 not properly within the scope of 30(b)(6) designated testimony
9 in his deposition transcripts that's, we believe, improper and
09:34:04AM 10 should be outside the scope --

11 **MAGISTRATE JUDGE FELDMAN:** Maybe I need to take
12 another look at 30(b)(6), but let's say you have somebody who
13 is a 30(b)(6), but also is intricately involved in the facts
14 of the case.

09:34:17AM 15 Normally you would be restricted on
16 cross-examination to topics that were testified to on direct
17 examination, but I've had a lot of cases where -- because for
18 convenience of the witnesses they don't want to bring them
19 back and put them on as an adverse witness on their case, they
09:34:34AM 20 would rather just cross-examine them on the other side.

21 I don't care what you do, but I don't think someone
22 can escape being asked questions about something they have
23 personal knowledge about simply because they're also
24 designated as a 30(b)(6).

09:34:46AM 25 **MR. DOMBROWSKI:** Okay.

1 **MR. SUSSEER:** Your Honor, I will just add two things.
2 One, as far as Aaron Shepherd, that was not my understanding
3 of the deal. They can question him on 30(b)(6) topics, but
4 also other topics that they designated. That's no problem.

09:34:59AM 5 **MAGISTRATE JUDGE FELDMAN:** What about topics they
6 didn't designate? What if they want to ask him about
7 something that they have the right to ask him about it, it's
8 relevant, that they could call him as their own adverse
9 witness --

09:35:12AM 10 **MR. SUSSEER:** I mean, if it's relevant, it's fine. I
11 mean --

12 **MAGISTRATE JUDGE FELDMAN:** My bad.

13 **MR. SUSSEER:** It's relevant, Your Honor -- look, if
14 it's relevant, they can ask Aaron Shepherd about it. It's
09:35:30AM 15 perfectly appropriate.

16 Mr. Meyering, I said to him would your personal
17 testimony be any different than your Rule 30(b)(6)? He said
18 no, it's the same.

19 I think we're really trying to micromanage
09:35:41AM 20 something that -- it's an organic process. There's
21 cross-examination, it will flow where it flows. As long as
22 the parties stick to relevant information, the jury can
23 ultimately sift it out.

24 **MAGISTRATE JUDGE FELDMAN:** Right. I know you have
09:35:52AM 25 this very specific agreement that you negotiated.

1 But what I'm saying is from my view, I'll enforce
2 whatever agreement you want, but it might be simpler if we say
3 a witness will testify once, if that's what you want?

4 **MR. SUSSER:** I agree to that.

09:36:13AM 5 **MAGISTRATE JUDGE FELDMAN:** And you can ask him
6 questions as though you call him as an adverse witness on your
7 own; or we have a rule that says no, we're gonna play it just
8 by the Federal Rules of Evidence that cross-examination is
9 limited to what was gone over on direct examination, and if
09:36:33AM 10 you want this witness to present something in your case that
11 he didn't or she didn't testify about on direct examination,
12 you have that right, but you've got to wait until the other
13 side rests.

14 So I'm not saying what you should do, but I think
09:36:47AM 15 you should think about it because the system that you have
16 now, which is are we inside a designation, are we outside a
17 designation, that's going to require me to become much more
18 familiar with the designations than I am right now and much
19 more familiar with the details of whatever agreement you
09:37:04AM 20 worked out, and I'm not privy to that.

21 So I think it's cleaner either if you go all the
22 way one way or all the way the other way.

23 **MR. DOMBROWSKI:** I understand.

24 **MAGISTRATE JUDGE FELDMAN:** And you can do it, as far
09:37:14AM 25 as I'm concerned, witness by witness. If there's some

1 witnesses you want to do that with, that's fine. If there's
2 some you don't want to do that with, that's fine.

3 **MR. DOMBROWSKI:** That's where we're at right now.
4 Leading up to this we already had this arrangement about Aaron
09:37:25AM 5 Shepherd. And now just recently it's being blown up into
6 these other witness and the dust hasn't settled on all that
7 yet.

8 So I guess where we're at is kind of like what you
9 said, we need to determine which witnesses -- what's going to
09:37:37AM 10 be done with each witness.

11 **MAGISTRATE JUDGE FELDMAN:** I think that's true.

12 **MR. SUSSEER:** Okay.

13 **MAGISTRATE JUDGE FELDMAN:** Unless you have a general
14 agreement.

09:37:41AM 15 So unless I hear otherwise, I'm either going to
16 enforce whatever agreement you've agreed on or I'm going to
17 enforce the Federal Rules of Evidence.

18 **MR. DOMBROWSKI:** I think that's what we prefer. We
19 have an agreement for Aaron Shepherd. And we're just asking
09:37:54AM 20 to enforce the Federal Rules for our witnesses.

21 **MR. KLINE:** We'll think about it.

22 **MAGISTRATE JUDGE FELDMAN:** Okay. All right?

23 **MR. DOMBROWSKI:** Couple other points to raise. One
24 is the preliminary jury instructions, that you said you would
09:38:08AM 25 rule on the disputed portions before trial.

1 We just need to get the jury binders together --
2 not to obviously force that on you.

3 **MAGISTRATE JUDGE FELDMAN:** I had forgotten about
4 that. In terms of preliminary instructions, I think once we
09:38:19AM 5 get the jury selected, we're going to show them the video and
6 hand out the kind of phoney patent that they follow along with
7 the video.

8 **MR. DOMBROWSKI:** Okay.

9 **MAGISTRATE JUDGE FELDMAN:** Okay? And then I've got
09:38:31AM 10 to take a closer look at your preliminary jury instructions.

11 **MR. DOMBROWSKI:** The thing I'll add to that is in
12 light of the recent developments this week on many fronts,
13 there are other things besides the disputed portions we may
14 need to tweak to make them correct now.

09:38:44AM 15 **MAGISTRATE JUDGE FELDMAN:** Why don't you, by the
16 close of business today, get me a revised preliminary
17 instruction?

18 **MR. DOMBROWSKI:** Okay, thank you. Another small
19 issue is we still have not received the privileged documents
09:38:56AM 20 you ordered them to produce which we would like to start
21 processing for our case.

22 **MAGISTRATE JUDGE FELDMAN:** Do you have those?

23 **MR. TOBIN:** We'll get those to them, Your Honor.

24 **MAGISTRATE JUDGE FELDMAN:** Get those to them by
09:39:02AM 25 1 o'clock this afternoon.

1 **MR. TOBIN:** One further issue, Your Honor, if I may?
2 When we sent the designations to the Court, the parties
3 exchanged designations and objections and what not, and when
4 we submitted them to the Court in the larger form it appears
09:39:19AM 5 we inadvertently included -- excluded one of the witnesses,
6 Emily Chew's designations. It was inadvertent.

7 We sent them to the other side once we realized,
8 and we have a copy here for the other side if they want and
9 one for the Court.

09:39:34AM 10 **MR. DOMBROWSKI:** I don't think we're going to fight
11 on that. We're fine with those coming in as it -- we had
12 dealt with them before -- oh, we're talking about Emily Chew?
13 We did not have any objections to those particular portions.

14 **MR. TOBIN:** There were no objections. I just wanted
09:39:44AM 15 to provide the Court with a copy.

16 **MAGISTRATE JUDGE FELDMAN:** Get me the transcript.
17 But there's no objections I need to rule on?

18 **MR. DOMBROWSKI:** Correct, Your Honor.

19 **MR. TOBIN:** Correct, Your Honor.

09:39:52AM 20 **MR. DOMBROWSKI:** Your Honor, we're confirming, we
21 can respond to whatever they submit by 1 by 5 o'clock today?

22 **MAGISTRATE JUDGE FELDMAN:** Yes.

23 **MR. DOMBROWSKI:** Okay, thank you.

24 **MAGISTRATE JUDGE FELDMAN:** Okay? All right, see you
09:40:19AM 25 on Monday.

(WHEREUPON, the proceedings adjourned at 9:40 a.m.)

* * *

CERTIFICATE OF REPORTER

In accordance with 28, U.S.C., 753(b), I certify that these original notes are a true and correct record of proceedings in the United States District Court for the Western District of New York before the Honorable Jonathan W. Feldman on July 29th, 2016.

S/ Christi A. Macri

Christi A. Macri, FAPR-CRR
Official Court Reporter